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Robert Kenneth Pliha

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EXAMINER

JANVIER, JEAN D

ART UNIT

PAPER NUMBER

3622

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

# Office Action Summary

Application No.

09/880,430

Applicant(s)

PLIHA, ROBERT KENNETH

Examiner

Jean Janvier

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-52 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Specification***

### ***Claim Status***

Claims 1-52 are currently pending in the Application.

### ***General Comments***

In claim 48, regarding the obtaining rankings of customers of one financial institution....” limitation, it appears that the specification only supports that the incentives, but not the customers, are ranked or categorized.

Further, in “receiving data of the customer from the financial institution”, as recited in claim 1 for example, the source of the customer data does not really impact the type of incentives provided to the customer. However, the type of customer data received, from any source or a third party, does impact the delivery of the incentives to the customer.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an

Art Unit: 3622

international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-4, 7, 9, 12, 14, 18, 19, 21-32, 34-47 and 48-52 are rejected under 35 U.S.C. 102(e) as being anticipated by Deaton, US Patent 5, 649, 114.

As per 1-4, 7, 9, 12, 14, 18, 19, 21-32, 34-47 and 48-52, Deaton et al teach, among other things, a system for distributing incentives (coupons) to customers based on factors such as demographics, recency, frequency, volume purchase data, timing of purchases or purchase cycle data, brand loyalty, coupon, redemption data and custom price sensitivity. These factors are used to develop coupon lists, associated with customers' transaction habits or tendencies, which are spooled to a coupon printer for delivery to the customers at the checkout register **or by mail**. Alternatively, the coupon lists may be spooled to an electronic medium, such as customers' smart cards, or a store's system controller mass storage device for automatic electronic redemption on a future bill (figs. 19-45).

Furthermore, Deaton et al teach a system for providing selective incentives to a customer if and only if the customer's shopping history or transaction history or purchase history meets some predetermined criteria, such as demographics, recency, frequency, volume purchase data, timing of purchases or purchase cycle data, brand loyalty, coupon redemption data and custom price sensitivity data and infrequent purchase data, as set forth by a retailer. Upon analyzing the shopping history data or purchase history data using a program subroutine as disclosed in figs. 18 and 23-47 or any conventional data mining technique, a decision is

Art Unit: 3622

made, subsequent to determining the customer's purchase habits or pattern or tendencies, on whether or not the said customer should receive a selective incentive and/or be targeted for a particular product promotion.

See Col. 1: 66 to Col. 2: 4; Col. 65: 61 to Col. 67: steps 40-46; Col. 68: 8-16; Col. 71: 4 to Col. 72: 58.

In addition, Deaton teaches a system wherein a customers' purchase history, such as price sensitive data, volume purchase data, frequency of shopping data, brand loyalty data and so on, is used not only to target the customers by offering different categories of discount **coupons (coupon A, coupon M, standard coupon, echo coupon etc)** redeemable on particular promotional products to the said customers, but also to anticipate or predict what the customers will purchase next and prepare a specific promotional package to target these particular customers (cot. 71: 30-45 and steps 200-211; cot. 100: 64 to cot. 101: 13; cot. 101: 48 to cot. 103). Deaton, for example, clearly points out that transaction tendencies or patterns can be used to at least divide customers into two groups, that is customers who are price sensitive and those who are not. Based on this grouping, two different promotional messages regarding a particular promoted product will be generated. The customer who is price sensitive will receive a coupon with a higher value to encourage him to buy the promoted product while the other customer will receive a coupon with a lower value to buy the promoted product, as depicted in col. 93: step 272. Moreover, customers are also ranked or categorized as frequent customers and infrequent customers based on their shopping history and are targeted accordingly in order to induce the customers to behave in a certain way or maintain a particular shopping pattern.

Art Unit: 3622

In general, Deaton discloses a system for providing customized incentives to qualified users or members based on the users' purchase history collected through a network of local stores. The users first register with the system and may receive frequent shopper's cards for electronic couponing and may use acceptable payment instruments such as checks, credit cards, and debit cards as valid identifications during purchases, including those involving redemption of printed coupons, so that their activities can be monitored and fraud incidents can be curtailed. In one embodiment, a user may receive a printed coupon during a transaction at a POS (or the printed coupon may be mailed to the customer) and the printed coupon is redeemable on a future trip at an associated store POS (figs. 19-21). Indeed, an alternate embodiment provides functions similar to the check verification system of FIGS. 1 through 18A-C for verifying checks and providing targeted marketing, **but enables the use of account numbers from a variety of financial payment or transaction instruments such as checks, credit cards and debit cards to be utilized as a customer identification number (identification marks used during a redemption or validation or verification process). Smart cards and marketing cards may also be utilized for the cash customer. This substantially enhances the breadth of uses of the present system and enables the retail store to track all customers whether or not they pay by check or not.** It should further be recognized that when the user uses a credit card to pay for a transaction at a POS, the credit card is be validated in a conventional manner by the credit card provider or issuer. The present system may thus be usable with checks, credit cards, debit cards, electronic checks (such as paperless check ACH), electronic benefits transfer such as food stamps, cards and the like, as well as proprietary merchant issued marketing cards for charging, check cashing identification or for marketing purposes which may or

Art Unit: 3622

may not be magnetically encoded or bar encoded, as well as a smart card containing nonvolatile memory. Of course, as previously noted, such proprietary merchant issued marketing cards have not been found to work well in practice for targeted marketing, but the present system may be used to accept their customer identification codes in order to enhance the universality of the present system (col. 70: 30-64).

Furthermore, the subsequent performance of a customer is tracked, via the payment instrument identification used, by the present system to determine which coupons are redeemed or not by the customer, or to determine the customer's response to the incentive. The marketing program of incentives may then be changed by the system based upon that customer's subsequent performance. Thus, performance may be tracked or monitored by the present system at a product level, a department level or a store level (col. 70: 65 to col. 71: 17 and see embodiment of fig. 34).

Finally, **although various types of payment instruments and identification instruments have been illustrated for use with the AP/M in FIG. 21, it will be appreciated that other types of payment instruments bearing unique identification numbers are envisioned for use with the present system, both to provide payment identification for verification but also to provide unique identification of customers for the marketing techniques of the present invention (col. 77: 45-52).** It is further contemplated here that a user can bring a coupon printed at one store to another store for redemption. In this case, the user should be properly identified, using any form of identification as described above, in conjunction with the remote server (figs. 19-21; col. 74: 37-67) before the redemption can be performed (validation process).

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-4, 7, 9, 18, 21, 22, 25-27 and 29-34 are rejected under 35 U.S.C. 102(e) as being anticipated by Barnett, US Patent 6,321,208.

As per 1-4, 7, 9, 18, 21, 22, 25-27 and 29-34, Barnett discloses a system for distributing in an interactive manner over a computer network or the Internet by an online service provider 2 of fig. 1 electronic coupons (Virtual coupons) received from coupon issuer 14 or coupon distributor 16 to registered users using remote computers 6 of fig. 1 wherein a central repository or database 40 of fig. 6 associated with online service provider 2 stores electronic coupon packages and a database file 42 stores users' demographic data or profile data (name, address, income, etc.), provided by the users during an online registration process with the online service provider 2, and survey responses given by the users. First, a user initially visits the online service provider 2 web site and downloads or accesses generic or untargeted electronic coupons or



Art Unit: 3622

coupon data stored in database 40 and the demographic data collected from the user during the initial visit (registration process) are used to target specific coupon data packages for subsequently downloading by the user. It is further understood that those specific coupon data packages generated for the user or specific user are stored in the database 40 of the online service provider 2 along with uniquely created user-specific identification indicia uniquely identifying the user or customer using or participating in the online coupon distribution system (col. 7: 55 to col. 8: 5; Claim 1 of the current reference). Once the user joins the online coupon distribution system subsequent to the registration process during the initial visit, the user can connect or access or log into, by inputting via a keyboard his identification number or user-specific ID and/or login name, the online service provider 2 system having an associated web site where the said user can download (request) from database 40 of the online service provider 2 targeted coupon data, specifically directed to his attention, to his personal computer 6 where the coupon data can be stored in a local database 30 of fig. 2 or used by the user to print one or more coupons 70 as shown in fig. 5 using a printer 8 attached to the user's computer 6 (col. 8: 22-37; col. 8: 46-47; col. 6: 50 to col. 7: 11; col. 9: 33-52). The one or more printed coupons are presented for redemption in the normal or conventional fashion by the specific user or customer when shopping at a desired retailer. Following the redemption process, the redeemed coupon data are transmitted by the desired retailer to a coupon redemption center 13 where they are electronically read and the user-specific data are recorded in a coupon redemption database (D/B) 12. Additionally, the user's transaction data including the redeemed coupon data (redemption data) are provided to the coupon issuers 14 and coupon distributors 16 of fig. 1 for integration into further marketing analysis; in order words, the coupon issuers 14 and coupon

Art Unit: 3622

distributors 16 of fig. 1 utilize the user-specific data (coupons deleted, coupon printed and demographic data) along with the redemption data to generate or compile subsequent coupon packages targeted specifically or directed to the user's attention (using redemption data to update the user's virtual coupons or electronic coupons) (See abstract; col. 6: 58-65; col. 7: 12-20; col. 7: 45-55).

Barnett further discloses the steps of receiving over the Internet, for storage and later retrieval, by an online service provider 2 of fig. 1 a specific electronic coupon image or coupon data from coupon distributor 16 of fig. 1 and/or coupon issuer 14 of fig. 1 directed (targeted) to a specific user or customer based on the user's or customer's profile, received by the online service provider 2 from the user or customer during an initial contact and stored in a database file 42 of fig. 6 coupled to a server related to the online service provider 2, used by the coupon distributor 16 or coupon issuer 14 to prepare customized coupon packages (coupon images) for the specific user or customer and wherein the specific electronic coupon or targeted coupon data are displayed or distributed the specific user when the user logs into a web site of the online service provider 2 and wherein the targeted coupon data are utilized by the user to produce an electronic coupon image that can be printed by the specific user to obtain a hard copy of the electronic coupon image 70, redeemable at a specific POS (See abstract; col. 4: 40 to col. 5: 62).

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an

Art Unit: 3622

international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-4, 7, 9, 12, 14, 18, 19, 21, 22, 25-27, 29 and 31-47 are rejected under 35 U.S.C. 102(e) as being anticipated by Scroggie, WO 97/23838A1.

As per claims 1-4, 7, 9, 12, 14, 18, 19, 21, 22, 25-27, 29 and 31-47, Scroggie teaches an incentive distribution network or system over the Internet wherein a plurality of purchasing incentives and shopping aids are made available for qualified customers through the Internet or via e-mail. A customer (10) of retail stores, logs into the system and then elects to browse among available purchasing offers (18, 22), elects to claim a product rebate or to receive product information. The system merges customer's supplied information (270) with other purchase incentive data (272) and creates a printable graphical image of the purchasing incentive (282) for transmission to the customer. In an alternate embodiment, the purchase incentive is not transmitted directly to the customer. Instead, the terms of the incentive are transmitted electronically to the retail store (310) of fig. 13 designated by customer (10) or located in the customer's geographical region, who receives either a token (316) having at least a specific code or a bar code to present at the store or an advisory message used along with other identification to identity the customer at the POS during a redemption process. Further, in yet another embodiment, incentives may be targeted to specific customers based on a customer's purchase

Art Unit: 3622

history (502), when the customer uses a payment instrument such as a debit card or credit card during transactions at POSes, and transmitted to the consumers by e-mail using the customers' e-mail addresses stored in a consumer database (506). In other words, notification or indication of the availability of these incentives is transmitted to the customers in the form of Internet messages, for retrieval when the customers or consumers next access a web site associated with the system or check their e-mails. Finally, the incentive message informs a customer that one or more specific offers are available and can be received at a participating POS when the prerequisite products are purchased. Alternatively, subsequent to receiving an e-mail notification or an indication of an incentive offer, an image of a paper coupon may be transmitted to the customer's computer site and printed for later presentation at pre-selected POS (See abstract; page 9: 22-30; page 12: 23-25; page 13: 2-3; page 15: line 3-10; page 20: 2-8; page 20:16 to page 21: 30; figs 9 and 11-15).

As described above, the customer or user 10 is allowed to receive more targeted or focused incentives if he provides additional information regarding his identity such as financial accounts or payment instruments (credit card or debit card or check-cashing card number-page 6: 13-17; fig. 14).

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

Art Unit: 3622

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-22, 25 and 27-34 are rejected under 35 U.S.C.102( b) as being anticipated by Jheeta, U.S Patent 5,619, 558A.

As per claims 1-22, 25 and 27-34, Jheeta discloses a method for segment of one marketing to a customer who utilizes an automated teller machine (ATM) coupled to an ATM network of a financial institution. The ATM dispenses to the customer, subsequent to receiving an input such an ATM or debit card entry from the customer, a receipt containing a transaction record, a promotion, and a telephone number for redeeming the promotion. When the customer calls the associated telephone number, a telephonic survey is conducted and includes questions relating to products and services offered by a marketer. Answers to the survey questions are stored in a customer profile in a computer database, and the promotion is sent to the customer. The customer profile is used to generate a segment of one target message specific to the customer, which offers a specific product or service from the marketer based on the stored customer profile. The target message is then sent to the specific customer to complete the segment of one marketing (See abstract; figs 1-5; col. 1: 45-59).

### **Conclusion**

**Any inquiry concerning this communication from the Examiner should be directed to Jean D. Janvier, whose telephone number is (571) 272-6719. The aforementioned can normally be reached Monday-Thursday from 10:00AM to 6:00 PM EST. If attempts to**

Art Unit: 3622

reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. Eric W. Stamber, can be reached at (571) 272- 6724.

Non-Official- 571-273-6719.

Official Draft : 571-273-8300

03/17/07

**JDJ**

**Jean D. Janvier**

**Patent Examiner**

Art Unit 3622

JEAN D. JANVIER  
PRIMARY EXAMINER  
*Jean D. Janvier*